

Remarks

This Supplemental Response to Restriction Requirement is being submitted to correct and clarify two of the species elections made in the previous response. Specifically, the metabolite species election is changed herein from “target metabolite” to “wherein the metabolite mixture comprises saccharides, alcohols and acids” and the fungal species election is being changed from “white rot” to “*Neurospora intermedia*.” No other changes have been made herein. For convenience the entirety of the previous response has been included herein with the revisions incorporated where appropriate.

The PTO requires the restriction of the claims in the above-identified application into one of the following two groups of claims.

Group I: Claims 32-82 and 84, allegedly drawn to a method for producing an enzyme mixture.

Group II: Claim 83 allegedly drawn to an enzyme mixture.

The Examiner has also required election of species once the group election has been made. There the examiner is required election of one species of enzyme mixture, one species of metabolite, one species of substrates, one species of microorganism, one species of fungi, and one species of reactor.

Applicants provisionally elect Group I (claims 32-82 and 84) with traverse. Applicants further elect the following species with traverse: wherein the enzyme mixture is a hydrolytic/oxidative enzyme cocktail (claims 32-82 and 84); wherein the metabolite mixture comprises saccharides, alcohols and acids (claims 32-82 and 84); wherein the substrate is a target substrate (claims 32-82 and 84); wherein the microorganism is a fungi (claims 32-82 and 84); wherein the fungi are *Neurospora intermedia* fungi (claims 32-42, 44, 45, 49-60, 61-82 and 84); and wherein the reactor is a screw reactor (claims 32-82).

Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would result if all the claims are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence

of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803.

Applicant submits that the Examiner has not shown that it would be a serious burden to search and examine groups I and II together. In particular any search for a method of producing the enzyme mixture claimed in claim 83 would necessarily be a search for the enzyme mixture of claim 83. Since little or no additional burden would be required to search and examine the groups together, applicant respectfully submits that the Office should search and examine groups I and II together. Indeed it would be most efficient for the Patent Office to keep them together. For at least these reasons, Group II should be rejoined with Group I.

Moreover, Applicants note that the Examiner has provided no evidence to support that the methods of Group I can make an enzyme mixture other than the mixture of Group II and conversely that the enzyme mixture of Group II can be made by a different method than the method of Group I. Applicants respectfully remind the Examiner that the Examiner's burden of proof is not met by merely asserting that the mixture of claim 83 can be produced by a different method than claimed in Group I and that the method of Group I could make an enzyme mixture other than that of claim 83. The Examiner must provide reasoned arguments and evidence to make such a claim otherwise the Examiner's assertions are without merit. Applicants respectfully point out that the Examiner has not met his burden. For at least these reasons, Group II should be rejoined with Group I.

Regarding the species elections, Applicants respectfully point out that as discussed in the 37 C.F.R. § 1.141(a), an application may claim a reasonable number of species within a claimed genus as long as at least one genus claim encompassing all of the species is patentable. The Examiner has indicated that a *specific* species of each of the 6 groups must be elected. Applicants assert that this is not an appropriate application of the 37 C.F.R. § 1.141, which is aimed at situations where there are unreasonable numbers of species claimed. The present situation is not a situation where the applicants are claiming a genus of compounds, for example, a set of 1000 different nucleic acid molecules, and also claiming each of the encompassed species separately, which would be an appropriate circumstance for application of the election of species requirement. Rather, applicants have claimed in each genus a small number of species possibilities. Applicants are not required in the present application to elect a species when

applicants have not claimed an unreasonable number of species. Thus, when a genus claim is found to be patentable, Applicants understand that the remaining members of the reasonable number of species must be examined.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Examining all of the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related, applications. Thus, applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Pursuant to the above amendments and remarks, reconsideration and allowance of the pending application is believed to be warranted. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of this application to issue.

No payment is believed to be due; however, the Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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J. Gibson Lanier, Ph.D.

November 3, 2009
Date